

Remarks

In a July 12, 2004 office action, the Examiner sustained the rejection of Claims 1 and 4-15. That rejection has been made final. The Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 1 and 4-15 under Section 103 citing USPN 6,012,890 issued to Celorio Garrido in light of USPN 4,589,376 issued to Burton alone or in further view of an October 1987 article in PC Magazine (10/1987) or a March 1998 article from the New Statesman (3/1998). To establish a prima facie case of obviousness, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142.

Claims 1 and 4-6 are directed to a book manufacturing method with each of Claims 4-6 depending from Claim 1. Garrido, Burton, and the two articles cited by the Examiner fail to teach one or more limitations required by each of Claims 1 and 4-6.

Claim 1 is directed to a book manufacturing method. As amended, Claim 1 requires the following limitations:

- a) identifying a set of books;
 - b) receiving a dimension of a book storage space;
 - c) selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;
- and

- d) manufacturing the set of books according to the selected format criteria and using the selected page and cover media.

Garrido discusses producing books in four sizes – those sizes being dictated by the sizes of commercially available sheets of paper. Col. 7, lines 29-46. The user selects the paper size, and the user selects size and type fonts to be used. Col. 7, lines 23-28 and 47-49. *Garrido places no restriction on the font size or paper size the user can select. Garrido makes no mention of receiving measurements of a book storage space and producing books to fit in that space.*

In stark contrast, Claim 1 requires that a set of books be produced to fit in a book storage space – the production of the books being guided by a dimension of that storage space and the particular set of identified books. To that end, Claim 1 requires the selection of format criteria (that defines at least a font size) and page and cover media according to the received dimension and the identified set of books so that when produced, the set of books will fit in the book storage space. This requirement is not taught by Garrido.

Burton teaches a custom manufacturing process where a customer's measurements are taken and transmitted to a computer where an order is generated. The order is transmitted to a remote location for manufacture. An article of clothing is then manufactured according to the customer's measurements. Burton, Abstract. In short, Burton teaches receiving a measurement of a customer (not a book storage space) and tailoring a garment according to that measurement.

Claim 1, on the other hand, requires identifying a set of books, receiving a dimension of a book's storage space, and selecting format criteria that includes at least a font size and page and cover media according to the identified books and the received dimension none of which is taught by Burton.

Nothing in Burton or Garrido expressly or inherently teach selecting format criteria and page and cover media according to the received dimension and the identified set of books where the format criteria defines at least a font

size. The Examiner contends that it "would have been obvious for an artisan to select a format criteria defining font size and paper and cover media so that the book can be properly printed and sized to fit the item holder in the future after manufacturing." The Examiner continues: "selecting a font size too high or big will increase the book thickness or height which may not fit the book holder."

The Examiner's position can be based on nothing but hindsight. To create a garment that fits a particular customer, Burton teaches laser cutting of garment pieces (according to given dimensions) from a larger piece of fabric and assembling those pieces to form the garment. Compared to the present invention, the teachings of Burton are akin to cutting pages of a particular size from a roll of paper and binding those pages to form a blank book. That, by itself, is of no use to the reading customer. The present invention requires much more. The present invention requires that the bound pages include the text of a selected book. The application of Burton has no bearing on the selection of a font size that limits the number of pages required to manufacture a book and allows that book to fit within a particular space. There is no such similarity between Burton and the present invention.

Burton merely teaches the manufacture of a garment that fits a defined body size. Not only does claim 1 require the manufacture of a physical object that fits in a defined space, it requires that the physical object contain the text of a selected book. So that these requirements can be met, format criteria that include at least a font size, are selected so that a book having a limited physical dimension can contain the selected text.

Consequently, Garrido and Burton, alone or in combination, fail to teach a book manufacturing method requiring that media and format criteria (that includes at least a font size) be selected according to an identified set of books and a given dimension of a book storage space. Moreover, those references fail to teach that the selections be made so that the set of books, once manufactured, fits within the book storage space. For these reasons, Claim 1 is felt to distinguish over the cited art.

Claims 4-6 each depend from Claim 1 and include all the limitations of that base claim. For the same reasons Claim 1 distinguishes over the cited art, so do Claims 4-6.

Claims 7-11 are directed to a book on demand manufacturing system with each of Claims 8-11 depending from Claim 7. Claim 7, as amended, requires the following limitations:

- a) an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;
- b) a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and
- c) a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

In short, Claim 7 is directed to a system for performing the method steps of Claim 1. Rejecting Claim 7, the Examiner stated "it would have been obvious to a skilled artisan to set up a system ... to carry out the method steps as shown on claim 1."

As noted above, Garrido, Burton, and the cited articles fail to teach one or more limitations required by Claim 1. Consequently, the cited references do not teach all the limitations required by Claim 7. For these reasons, Claim 7 and Claims 8-11, which depend from Claim 7, are felt to distinguish over the cited art.

Claims 12-15 are directed to a computer readable medium having instructions relating to the manufacture of a set of books. Claims 13-15 depend


from Claim 12. Claim 12 requires instructions for performing the method steps of Claim 1. For the same reason Claim 1 distinguishes over the cited art, so do Claims 12-15.

Conclusion

In view of the foregoing remarks and amendments, the Applicant respectfully submits that claims 1 and 4-15 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,
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